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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/901,600 | 07/11/2001 | Oliver Wendel Gamble | | 7631 |
| 7590 | 06/04/2004 | | EXAMINER | |
| Oliver W. Gamble 436 E 75th Str. New York, NY 10021 | | | CONTEE, JOY KIMBERLY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2686 | |
| | | | DATE MAILED: 06/04/2004 | 7 |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/901,600 | GAMBLE | |
| | Examiner | Art Unit | |
| | Joy K Contee | 2686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 9,10,12,21-24,34-37 and 43-45 is/are allowed.
- 6) Claim(s) 1-8,11,13-20,25-33 and 38-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 September 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

1. Applicant's remarks and amendment filed March 11, 2004 have been fully considered but they are not persuasive.

In response to applicant's remarks and amendment with respect to claims 1,13,40-42, the recitation "**using a[said] wireless device**" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11,17,30,35,38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 11,17,30 and 35 recite the limitation "**the cell phone**" in lines 6 and 4 (see claim 35), respectively. There is insufficient antecedent basis for this limitation in the claim (e.g., claim 11 refers to "the cell phone", claim 11 is dependent on claim 9, claim 9 as amended still does not mention a "cell phone".)

5. Claims 38 and 39 recite the limitation "the router". There is insufficient antecedent basis for this limitation in the claim (e.g., claim 38 depends from claim 21, claim 21 recites in the preamble, "a system for routing calls", but does not recite a "router").

Claim Objections

6. Claims 38-39 are objected to because of the following informalities: "Router" should begin with a lower case "r". Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8,13-16,18-20 and 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Bubien, Jr. et al. (Bubien), US Patent No. 5,638,433.

Regarding claims 1,13,40-42 Bubien discloses a method (and inherently computer software) for routing calls through a discount telephone service, comprising: determining whether an outgoing call is a discount call (col. 3,lines 4-18); collecting the digits corresponding to the discount call (col. 3, lines 30-53); and dialing the access number for a discount telephone service provider and the digits corresponding to the discount call (col. 3,lines 4-27).

In regards to claims 25, Bubien discloses the method and system for routing calls through a discount telephone service, comprising: monitoring a telephone line for an

outgoing call activity; determining whether the outgoing call is a potential discount call (col. 3 lines 4-18); detecting the IDTIVIF tones corresponding to a first predetermined number of IDTIVIF tones (col. 2-3 lines 63-11), wherein the determining whether the outgoing call is a potential discount call is accomplished by determining whether the first predetermined number of at least one IDTIVIF tone meets a predetermined sequence of the IDTIVIF tones (col. 2-3 lines 63-11 and col. 3-4 lines 54 -20); collecting the digits corresponding to the discount call; determining whether all of the numbers associated with the discount call have been collected within a predetermined polling period (Fig. 2, col. 2 lines 17-23, and col. 3-4 lines 54-65); and dialing the access number for a discount telephone provider and the digits corresponding to the discount call (col. 1 lines 58-65 and col. 2-3 lines 63-3).

In regards to claims 2, 14,26, Bubien discloses the method and system, further comprising: detecting a first predetermined number of electrical signals encoding the digits corresponding to the discountable call (col. 2, line 63 – col. 3, line11).

In regards to claims 3,4,15,16,27 and 28, Bubien discloses the method and system, wherein the determining whether a discountable call is made is accomplished by determining whether the first predetermined number of said electrical encoding the digits of an outgoing call meets a predetermined sequence of digits (and inherently zero, and zero in a predetermined position) (col. 2-3 lines 63-11 and col. 3-4 lines 54-20).

In regards to claims 5 and 29, Bubien discloses the method according to claim 2, wherein determining whether an access code is required to effectuate said routing (i.e.,

reads on before send key command); and providing said access code when said code is required (col. 1,lines 44-54 and col. 3,lines 4-18).

In regards to claims 6,18,31, Bubien discloses the method and system, wherein the outgoing call is an international call (col. 3 lines 35-43).

In regards to claims 7,19,32 Bubien discloses the method and system, wherein the outgoing call is not a special service call or toll free call (col. 3 lines 35-46).

In regards to claims 8,20,33 Bubien discloses the method and system, further comprising: selecting the access number among a plurality of access numbers for discount telephone service providers; and dialing the selected access number of the associated discount telephone service provider (col. 1 lines 58-65 and col. 2-3 lines 63 3).

Allowable Subject Matter

9. Claims 9,10,12 ,21-24,34-37 and 43-45 are allowed.
10. Claims 11,38 and 39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on 5:30 a.m. to 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.


Joy K. Contee

May 29, 2004


CHARLES APPIAH
PRIMARY EXAMINER